

### **REMARKS**

The Applicants acknowledge, with thanks, receipt of the Office Action mailed August 11, 2004. The Examiner has withdrawn the restriction requirement and has reinstated claims 30, 31, 54, 55 and 61-72. Claims 22-34, 41, 42, 54, 55 and 61-74 were pending in the instant application. Applicants have canceled claims 28-31, 54, 55, and 61-72. Claims 22-24, 26, 27, 32-34, 41, 42, 73 and 74 remain pending in the instant application.

### **Non-Art Matters**

#### **I. Specification**

The Examiner has asserted that the specification discloses sequences which require the appropriate sequence identifiers. According to the Examiner, the sequences disclosed in the specification correspond to those in the sequence listing, but fail to include the sequence identifier. To conform to the Examiner's actions, Applicants have included amended paragraphs, set forth above, which include the appropriate sequence identifiers (SEQ ID NO).

#### **II. Oath/Declaration**

The Examiner has determined that the oath or declaration is defective for not including the post office address of Richard Lathe. Accordingly, Applicants are including an updated document containing Richard Lathe's post office address.

### **Art Matters**

#### **I. Claim Rejections - 35 U.S.C. § 112 2nd Paragraph**

The Examiner has rejected claims 22-24, 26-31, 41, 61 and 62 under 35 U.S.C. § 112(2) as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants have canceled claims 28-31, 61 and 62. Applicants acknowledge, with thanks, the Examiner's suggested wording for independent claim

22, which would overcome this rejection. Applicants accept the Examiner's suggested wording with the additional changes to claim 22 set forth in the claim listing above.

Specifically, Applicants submit that the method is for inserting a gene of interest, rather than a *heterologous gene coding sequence*. Applicants believe that this language more accurately defines the subject invention, as homologous recombination may occur at different positions along X and Y such that not the entire X and/or Y portions are, strictly speaking, inserted, but the gene of interest is inserted.

Furthermore, Applicants respectfully submit that, in accordance with the insertion of a gene of interest, the method is such that the gene of interest is expressed, rather than the *heterologous gene coding sequence expresses a gene of interest*. In addition, X and Y are of sufficient length to insert the A-P-B-Q-C elements, not the *A-P-B-Q-C-Y* elements, i.e., reference to the element Y has been deleted. Applicants believe that such a change is in accordance with the previously discussed amendments as well as is apparent from the context of the claim. Additionally, in accordance with the submitted amendments, A, B, and C are said to be each independently a linker sequence or a covalent bond.

The claims depending from claim 22 have also been amended, where appropriate, to reflect the changes made herein to independent claim 22. For example, claim 26 has been amended to reflect the identification of cells expressing the gene of interest.

The Examiner has rejected claims 32-34, 42, 73 and 74 under 35 U.S.C. § 112(2) as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants acknowledge, with thanks, the Examiner's suggested wording for independent claim 32, which would overcome this rejection. Applicants accept the Examiner's suggested wording with the additional changes to claim 32 set forth in the claim listing above and explained above with respect to independent claim 22 regarding the use

of a gene of interest and the A-P-B-Q-C elements. Claims depending from claim 32 have also been amended to reflect the aforementioned changes to independent claim 32.

The Examiner has also included suggested amendments to claim 73. Applicants acknowledge, with thanks, the Examiner's suggested language and have amended the claim accordingly, albeit, with the same additional limitations set forth with respect to claims 22 and 32.

The Examiner has rejected claims 54, 55 and 63-66 under 35 U.S.C. § 112(2) as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In response to the Examiner's rejection, Applicants have canceled claims 54, 55 and 63-66.

Other minor typographical and/or grammatical errors contained in the claims have been corrected. No new matter has been added to the claims by these amendments.

## **II. Claim Rejections - 35 U.S.C. § 112 1st Paragraph**

The Examiner has rejected claims 28-31, 54, 55 and 61-72 under 35 U.S.C. § 112(1) as failing to comply with the enablement requirement. In response to the Examiner's rejection, Applicants have canceled claims 28-31, 54, 55 and 61-72.

## **III. Claim Rejections - 35 U.S.C. § 102**

The Examiner has rejected claims 28-31, 54, 55 and 61-72 under 35 U.S.C. § 102(b) as being anticipated by Kim et al. (MCB 1992, cited in IDS filed 24 June 2002). In response to the Examiner's rejection, Applicants have canceled claims 28-31, 54, 55 and 61-72.

**CONCLUSION**

Applicants have canceled claims 28-31, 54, 55, and 61-72. In accordance with the Office Action dated August 11, 2004, the Examiner has indicated that claims 22-24, 26, 27, 32-34, 41, 42, 73 and 74 would be allowable if rewritten in the suggested form. Applicants hereby respectfully submit that such form has been met and that all remaining claims are patentably distinct over the art of record and in condition for allowance thereof. Applicants respectfully request that a timely Notice of Allowance be issued in this case. If the Examiner believes there are any further matters, which need to be discussed in order to expedite the prosecution of the present application, the Examiner is invited to contact the undersigned.

If there are any uncovered fees, or any overpayments, necessitated by the foregoing communication, please charge such fees to our Deposit Account No. 50-0902, referencing our Docket No. 78870-32932.

Respectfully submitted,

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